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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|-------------------------|---------------------|------------------|
| 09/467,387                | 12/21/1999  | EDUARDO PELEGRI-LLOPART | SUNIP253/P41        | 2336             |
| 22434                     | 7590        | 11/10/2004              | EXAMINER            |                  |
| BEYER WEAVER & THOMAS LLP |             |                         | KISS, ERIC B        |                  |
| P.O. BOX 778              |             |                         | ART UNIT            |                  |
| BERKELEY, CA 94704-0778   |             |                         | PAPER NUMBER        |                  |
|                           |             |                         | 2122                |                  |

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/467,387

Applicant(s)

PELEGRI-LLOPART ET AL.

Examiner

Eric B. Kiss

Art Unit

2122

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 26-42 would stand rejected under 35 U.S.C. §102(a) as being anticipated by [Fedorov98]

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s):

the rejection of claims 26-42 under 35 U.S.C. §112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because:


The Examiner maintains that the Final Rejection is in compliance with the requirements of 37 CFR 1.104(c)(2). For each reference in each claim, the pertinent portion of the applied reference is cited. Out of the total 991 pages in the [Fedorov98] reference, only the 160 pertinent pages were provided to Applicant. Further, the rejected claims are addressed individually (with the exception of claims 35-41, which closely parallel previously addressed claims, in which case only the additional limitations are addressed) with the specific portions of the 160 cited pages (out of 991) of the [Fedorov98] reference relied upon for each claim (and each limitation) clearly specified. Since the specific portions of the reference relied upon for each claim are clearly identified, the Final Rejection is clearly in compliance with 37 CFR 1.104(c)(2). Applicant's arguments that, for example, citing a 24-page (out of the total 991-page reference) section, with the specific heading under which the pertinent information can be found, is not specific enough, are simply without merit.

In the absense of any merited argument, and especially in the absense of any technical argument, the Examiner has no reason to withdraw the rejection. Accordingly, the rejection under 35 U.S.C. §102(a) is maintained.

Continuation of 10. Other: Any subsequent reply should be made in compliance with 37 CFR 1.111(b), which states, in relevant part:

The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references

The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

  
TUAN DAM  
SUPERVISORY PATENT EXAMINER